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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,145	12/02/2003	Fiorenzo Draghetti	20022/39789	2808

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EXAMINER

SIPOS, JOHN

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,145

Applicant(s)

DRAGHETTI ET AL.

Examiner

John Sipos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 and 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-12 and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

ELECTION

Applicant's election with traverse of Claims 19-28 is acknowledged. The traversal is on the ground(s) that the searching of the these claims also include the searching of the claims of the other groups and therefore there is no burden on the PTO. This is not found persuasive because the overlapped searching areas is not the criteria for restriction requirements and burden is present if the claims are directed to different inventions that require different rejections and consideration. As was stated in the last Office action, the three species set forth in the previous Office action are directed to different inventions and structures. The Group I specie is directed to folding rollers with V-shaped lateral surface; Group II specie is directed to a triangular folding edge; and Group III is directed to a folding mechanism and a vacuum guide.

An action on the merits of generic claims 1-3,7-12,16-18 and elected claims 19-28 follows.

The requirement is still deemed proper and is therefore made FINAL.

REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS

The following is a quotation of the second paragraph of 35 U.S.C. ' 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9,10,18,22 and 23-27 are rejected under 35 U.S.C. ' 112, **second paragraph**, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Contrary to lines 3- 5 of claim 9 the knife 30 and gripping

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head 10 do not rotate about the same axis. Note the second axis 33 about which the gripper wheel rotates is claimed in claim 10. Also, grippers 10 do not oscillate but rather rotate about their axis. The claim should be amended to clarify this structure. The scope of the invention recited in claims 10 and 18 is unclear in that the phrase that "the arm being orientable" does not positively set forth the intended manipulative step or the machine structure. The phrase only refers to a something that may or may not take place. It is suggested that claim 10 be amended by replacing the phrase with --moving the arm-- and in claim 18, line 7, delete the phrase "the arm being orientable, with respect to said transfer wheel, about " and insert in line 9, after "(33)" the phrase on said transfer wheel to move said arm with respect to said transfer wheel--.

The scope of claims 22 and 23 are unclear with the use of the words "preferably" and "return pulley" which do not define any method steps or positive structure.

Claim 24 is indefinite in that it recites that the transverse dimension of the folding profile at its end portion is half the dimension of the "folded" strip. As stated on page 9, lines 7 and 8 of the specification and shown in Figure 16, this dimension is half of the dimension of the unfolded strip.

REJECTIONS OF CLAIMS BASED ON PRIOR ART

The following is a quotation of 35 U.S.C. ' 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,11 and 12 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Thomas (5,250,134). The patent to Thomas shows a coupon attaching operation that comprises a strip unwinding mechanism (Figure 1) that feeds the strip continuously, a folding station 54 for longitudinally folding the strip along a number of fold lines, a cutting station 106 to cut the folded strip crosswise and means 146 attaching the cut coupons to wrapper. The difference between the claimed inventions is that the claims recite the attaching of the coupons to articles rather than to wrappers. It would have been obvious to one skilled in the art to attach the coupons of Thomas to articles rather than wrappers. Note that Thomas discloses in column 1, line 27-30 that the attachment of the coupons directly to articles is well known in the art.

Claims 7,8 and 16 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Thomas (5,250,134) as applied to the claims above, and further in view of the patent to Bardenhagen (4,004,395). The Thomas operation lacks the feeding of the material at different speeds to the machine. The patent to Bardenhagen shows a packaging machine in which strip material 43 (Fig. 4b) is fed continuously by rollers 46 to a roller 49 forming a bend in the strip and then to an intermittently rotating rollers 45 that feed the strip in steps to cutter 58,59 to allow the cutter to operate while the strip is at rest. It would have been obvious to one skilled in the art to substitute the feeding and cutting mechanism of Bardenhagen for the feeding and cutting mechanism of Thomas. Note that Thomas discloses the continuous feeding of the strip through the folder and the use of a bend 84 in the film downstream of the folding mechanism.

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Claims 9 and 17 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Thomas (5,250,134) in view of Bardenhagen (4,004,395), as applied above, and further in view of Patterson (3,963,557). The modified Thomas operation lacks the use of a rotating coupon gripping and applying mechanism. The patent to Patterson shows a coupon applying mechanism comprising a cutter 37 cooperating with anvil 38 and a rotating gripping mechanism that continuously applies and holds the coupons. It would have been obvious to one skilled in the art to substitute the rotating gripping mechanism of Patterson for the peel-type applying mechanism of Thomas to positively hold and control each coupon during the applying operation.

Claims 19-23 and 28 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Thomas (5,250,134) as applied to the claims above, and further in view of the patent to Blumle (6,572,520) or Buxton (4,682,977). The patent to Thomas does not show a guide device for holding the unfolded portion of the strip in place as the strip is folded by the fixed folding profile 62. The patents to Blumle and Buxton show a folding profiles 10 and 14, respectively, that fold the strip and conveyor guide device 2 and 13, respectively, looped about pulleys and which use vacuum 4 and 15, respectively, through the conveyors to hold the unfolded portions of the strip in place. It would have been obvious to one skilled in the art to provide the folding operation of Thomas with a vacuum conveyor as shown by either Blumle or Buxton to hold the unfolded portion of the strip during the folding operation. Regarding claim 28, the use of compensating devices is well known in the art and their use upstream of the folding mechanism of Thomas would have been obvious to one skilled in the art control the feed of the material. Regarding claims 22 and 23, the use of one of the pulleys as a return pulley

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would have been obvious to one skilled in the art and depends merely on the desired path of the material.

Claims 24-27 are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Thomas (5,250,134) as applied to the claims above, and further in view of the patent to Luce (2,332,647). The patent to Thomas does not show the design of the claimed folding profile. The patent to Luce shows a folding profile that comprises a folding edge sloping at an angle with the dimension of the profile being the full width of the material at the initial portion and half the width of the material at the end portion (see Figure 7). The end portion of the profile further extends longitudinally at a constant width and at a slope to the initial portion of the profile. It would have been obvious to one skilled in the art to substitute the folding profile of Luce for the profile 62 of Thomas to better define the folding shape of the strip. The use of rollers (claim 27) as folding members is well known in the art and would have been obvious to one skilled in the art to use rollers instead of deflector members 64,66 to reduce the friction between the material and the members.

ALLOWABLE SUBJECT MATTER

Claims 10 and 18 would be more favorable considered **if rewritten in independent form** to include all of the limitations of the base claim and any intervening claims and if rewritten as suggested to overcome the indefiniteness rejection..

ADDITIONAL REFERENCES CITED

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The following prior art is made of record but has not been relied upon in the rejection of claims. However, the prior art is considered pertinent to applicant's disclosure.

The patents to Spatafora, Focke, Mulet and Draghetti show coupon applying devices. Note that Focke shows the use of a magazine or a continuous web as the source for the coupons. Spatafora and Mulet show the coupon gripping heads mounted on wheels and which heads are orientable relative the wheel.

The patent to Neri shows a folding profile similar in shape to applicant's with the use of rollers as deflecting members.

The patent to Burnett shows vacuum conveyor to hold the unfolded portion of a strip.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **571-272-4468**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at **571-272-4467**.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is **571-272-3700**.


John Sipos
Primary Examiner